

**REMARKS**

Claims 1-6 are all the claims pending in the application.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Dobashi et al. (US 5,643,676) taken in view of EP '585.

Applicants respectfully traverse the rejection.

For the reasons of record, it is respectfully submitted that one of ordinary skill would neither have been motivated to combine, nor have a reasonable expectation of success by combining, the tackifiers disclosed in EP '585 with the coating formulas of Dobashi.

In addition, Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 executed by Mr. Tsuyoshi Inoue further showing unexpectedly superior results. The Declaration shows that when the sheets for protecting a paint film prepared according to the present invention (Examples 1 and 5) were applied to a paint film, no fouling occurred. In contrast, when a sheet prepared using the hydrogenated terpene-phenol resin (YS POLYSTER T115) disclosed in Dobashi was applied to a paint film, fouling occurred. That is, the film prepared using the hydrogenated terpene-phenol resin disclosed in Dobashi did not prevent fouling. As is apparent from the comparative data, the present invention provides unexpectedly superior results relative to Dobashi in terms of fouling property, and thus the present invention would not have been obvious in view of Dobashi.

Further, regarding the assertion that the fouling test is subjective with no standard, Applicants disagree and respectfully submit that the comparative data must be considered. In *In re Saunders and Gemeinhardt*, 170 USPQ 213 (CCPA 1971), the court held that "although we agree that objective comparisons are generally to be preferred to subjective comparisons, we

**RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/874,314**

**Attorney Docket Q64575**

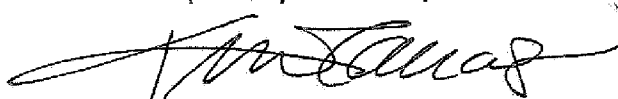
cannot agree that comparisons made in [subjective terms like "good" and "coarse"] can be completely ignored, nor that they are, for that reason alone, entitled to little weight where the Patent Office has not suggested a practicable objective standard for measuring the same variable." *Id.* at 219. In the present case, the fouling evaluation results were based on physical observation of the tested paint films, using the terms "fouling" and "no fouling". In addition, it is respectfully submitted that the Patent Office has not suggested a practicable objective standard for measuring the same variable.

In view of the above, it is respectfully submitted that claims 1-6 are patentable over the cited art, and withdrawal of the rejection is respectfully requested.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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